



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,364	07/18/2003	Troy L. Bartlett	034008.022WO	5350

7590 10/04/2006
Robert E. Stachler II
c/o Smith, Gambrell & Russell, LLP
Suite 800
1850 M Street, N.W.
Washington, DC 20036

EXAMINER

LU, CHARLES EDWARD

ART UNIT PAPER NUMBER

2163

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/622,364	Applicant(s) BARTLETT ET AL.	
	Examiner Charles E. Lu	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment/Response to Arguments

1. This Action is in response to the amendment dated 7/31/2006. Claims 1-40 are pending. Claims 1-40 are rejected.

2. Amendment to the specification and drawings has been noted. Objection to the drawings is withdrawn. Objection to the specification is maintained because of page 2, last line of the specification, described in a previous Action. Also, objection to the title is maintained because the title does not appear to be amended, and Applicants appear to have not addressed the title objection from the previous Action.

3. Amendment to the claims for addressing claim objections has been noted. Objection to the claims is withdrawn.

4. Remarks concerning the 35 U.S.C. 101 rejections have been considered. Rejections of claims 11-20 under 35 U.S.C. 101 are withdrawn. Rejections for claims 21-40 are maintained. As to claim 21 and its dependent claims, the specification states that a computer readable medium can be paper. Therefore, claim 21 is reasonably interpreted to be non-statutory and non-functional descriptive material. Furthermore, claim 21 can cover a signal, currently not believed to fall within a statutory category of invention. See Specification, pp. 24-25. As to claim 31 and its dependent claims, all of the "means for" is interpreted in light of the specification as software per se and non-statutory. The specification does not appear to show that any of the "means for" of claim 31 is implemented in hardware.

Art Unit: 2163

5. Amendments concerning the 35 U.S.C. 112, first paragraph rejections have been noted. The 35 U.S.C. 112, first paragraph rejections are withdrawn.

6. Amendments and remarks concerning the 35 U.S.C. 112, second paragraph rejections have been fully considered. The 35 U.S.C. 112, second paragraph rejections are withdrawn for claims 10, 18, 28, 31, and 38. The rejections are maintained for claims 3 and 21, and their dependent claims. As to claim 3, "the new set of settings" as amended on line 4 lacks antecedent basis. As to claim 21, the reasoning is maintained from the previous Action. As to claim 35, see below.

7. Arguments regarding the prior art rejection have been fully considered, but are not persuasive.

Applicants argue that Zanchi does not teach or suggest determining a set of settings used in an operation on a computer device. However, the examiner respectfully disagrees and points out all of the figures of Zanchi, which when read along with the related text, clearly teach the claimed subject matter (see previous Action for details). Applicants argue that Zanchi does not teach or suggest "general operations settings," but the examiner recognizes that the claims do not recite any "general operations settings." It should be noted that limitations that may appear in the specification to support "general operations settings" are not read into the claims.

With respect to claims 3, 13, 23, and 33, Applicants are arguing the claims as amended.

Art Unit: 2163

With respect to claims 4, 14, 24, and 34, the reasoning from the previous action is maintained. The examiner further recognizes that “and then” (Amendment, p. 17, second paragraph, line 5) is not recited in the claims.

With respect to claims 6, 16, 26, and 36, the reasoning from the previous action is maintained.

Rejections of the independent claims are maintained using the art of record. New grounds of rejection using the art of record are necessitated for amended claim(s) (e.g., claim 26).

Specification

8. The disclosure is objected to because of the following informalities:

Objection to the title is maintained. See the previous Action.

Objection to page 2, last line of the specification is maintained. See the previous Action.

Appropriate corrections are required.

Claim Objections

9. Claims 26 and 35 are objected to because of the following informalities:

As to claim 26, the status indicator should be changed to Amended because the claim appears to have been amended. The claim will be treated in this Action as being amended.

As to claim 35, there appears to be an amended portion "ordering...priority" that should be underlined. The amended portion is interpreted to be underlined.

Appropriate corrections are required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 21-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Rejections for claims 21-40 are maintained.

As to claim 21 and its dependent claims, the specification states that a computer readable medium can be paper. Therefore, claim 21 is reasonably interpreted to be non-statutory and non-functional descriptive material. Furthermore, claim 21 can cover a signal, currently not believed to fall within a statutory category of invention. See Specification, pp. 24-25.

As to claim 31 and its dependent claims, all of the "means for" is interpreted in light of the specification as software per se and non-statutory. The specification does not appear to show that any of the "means for" of claim 31 is implemented in hardware.

The art rejection of the above claims is applied in anticipation of Applicant amending the claims to overcome the rejection under 35 U.S.C. 101, discussed above.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 3, 21, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejections are maintained for claims 3 and 21, and their dependent claims.

As to claim 3, “the new set of settings” as amended on line 4 lacks antecedent basis.

As to claim 21, the reasoning is maintained from the previous Action.

As to claim 35, the claim appears unclear because of sentence structure.

The broadest reasonable interpretation of the above terms in light of the specification has been given to the claims. The art rejection of the above claims is applied as best understood in light of the rejection under 35 U.S.C. 112, second paragraph, discussed above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 2, 7-12, 15, 17-22, 25, 27-32, and 37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Zanchi et al of record (U.S. Patent 5,633,484).

As to claim 1, Zanchi teaches the claimed subject matter including:

Determining an operation on a computer device (col. 9, ll. 25-40);

Determining and acquiring a set of settings to perform the operation on the computer device (col. 7, l. 60 – col. 8, l. 15);

As to claim 2, Zanchi teaches wherein the acquiring comprises searching a database for the set of settings (i.e., from a direct search, fig. 11, fig. 14, fig. 15, col. 8, ll. 10-20).

As to claim 7, Zanchi teaches wherein determining the set of settings comprises determining an environment of the computer device (fig. 12, #1240).

As to claims 8 and 9, Zanchi teaches determining the set of settings for a user (col. 9, ll. 47-49) or a group of users (col. 9, ll. 52-54).

As to claim 10, Zanchi teaches determining an application setting for the operation on the computer device, the application setting being authentication (col. 9, ll. 48-54).

Claims 11-12, 17-22, 27-32, and 37-40 are drawn to a system or computer readable medium claiming the same invention as method claims 1-2, and 7-10. Therefore, claims 11-12, 17-22, 27-32, and 37-40 are rejected based upon the same reasoning as stated above in the rejection of claims 1-2, and 7-10.

As to claim 15, Zanco teaches a preference module (program code) that determines a preference between multiple sets of settings when there are multiple sets of settings (col. 3, l. 59 – col. 4, l. 5).

Claim 25 is drawn to a system or computer readable medium claiming the same invention as system claim 15. Therefore, claim 25 is rejected based upon the same reasoning as stated above in the rejection of claim 15.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3-6, 13-14, 16, 23-24, 26, 33-35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zanchi et al of record (U.S. Patent 5,633,484).

As to claim 3, Zanchi teaches creating a new set of settings in a database (the set of settings of fig. 11 have to be created), comprising selecting an existing set of settings (col. 12, ll. 14-16, col. 8, ll. 24-27), and modifying the set of settings (refining the settings from established settings involves modifying the existing settings, col. 8, ll. 24-27). Zanchi further teaches storing data in the preference memory database (fig. 11, col. 12, ll. 15-16).

Zanchi does not expressly teach for the new set of settings, copying the data into a location.

However, official notice is taken that at the time the invention was made, copying data to a database was conventional.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zanchi with the above teachings, such that as new settings are stored in the reference preference memory (fig. 11), the data is copied to the appropriate cell (fig. 11) in the database. The motivation would have been to adapt to the particular requirements of the user or designer. For example, copying the data retains the data from the source as well as copies data to the destination, which will increase data availability.

As to claim 4, Zanchi teaches determining a second set of settings. This is performed when a set of most recent preference entries in a reference preference set

(fig. 11, col. 3, l. 59 – col. 4, l. 4) are found. Zanchi further teaches acquiring a first set of settings to perform an operation on a computer, as described above.

Zanchi does not expressly teach that the second set is from a setting in the (first) set of settings, or acquiring a second set of settings.

However, Zanchi teaches a first set of settings (fig. 11, col. 7, l. 60 – col. 8, l. 15). Zanchi further teaches a second set of settings (i.e., a more recent set), as described above. Therefore, the more recent set of settings can correspond to the more recently updated settings for a particular cell, as each cell contains particular user settings (fig. 11) in a preference memory (col. 3, l. 59 – col. 4, l. 5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zanchi with the above teachings, such that a second set of settings, in the first set of settings, i.e., the more recently updated settings within a cell, are determined and acquired for performing an operation on a computer device. The motivation would have been to facilitate reconciling of multiple conflicting preference sets, as taught by Zanchi (col. 3, l. 59 – col. 4, l. 4), and presenting the user with his/her preferences, taught throughout Zanchi.

As to claim 5, Zanchi, as modified above, further teaches determining a preference between multiple sets (old set vs. new set) of settings (using a time stamp) when there are the multiple sets of settings (col. 3, l. 66 – col. 4, l. 4).

As to claim 6, Zanchi, as modified above, teaches using a concept of priority (i.e. the most recent time stamp, col. 4, ll. 1-4) to determine a preference between multiple conflicting sets of settings.

Art Unit: 2163

Zancho does not expressly teach ordering the sets by priority.

However, Zancho suggests that there are at least two time stamps (e.g., old and new), for obtaining “most recent entries” (col. 4, l. 1).

Furthermore, official notice is taken that at the time the invention was made, it was conventional to order (sort) values.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zancho with the above teachings, such that time stamps are ordered by time priority. The motivation would have been to facilitate finding the most recent time stamp (Zancho, col. 4, l. 1) when there is a list of times.

As to claim 35, Zancho teaches, “determining...settings” as shown above for claim 5. As to ordering the multiple sets of setting by priority, see the rejection for claim 6.

Claims 13-14, 16, 23-24, 26, 33-34, and 36 are drawn to a system or computer readable medium claiming substantially the same invention as method claims 3-6. Therefore, claims 13-14, 16, 23-24, 26, 33-34, and 36 are rejected based upon the same reasoning as stated above in the rejection of claims 3-6.

Conclusion

14. Applicant's arguments have been fully considered but are not persuasive. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

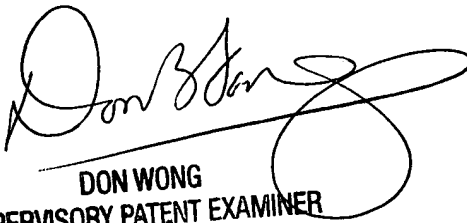
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Lu whose telephone number is (571) 272-8594. The examiner can normally be reached on 8:30 - 5:00; M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2163

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CL
Assistant Examiner
AU 2163
9/19/2006



DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100